

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Beer et al.

Group Art Unit:

Serial No. : 10/561,134

Filed : December 15, 2005 Examiner:

For : OPTICAL AMPLIFYING MATERIALS

Date: February 22, 2007

Mail Stop PCT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attention: OFFICE of PCT LEGAL ADMINISTRATION

RESPONSE TO DECISION ON APPLICANT'S
PETITION UNDER 37 CFR 1.181

Examiner Sir/Madame:

This communication is in response to a Decision mailed to Applicants on January 24, 2007 (a copy is enclosed herein).

In the Decision Applicant's petition under 37 CFR 1.181 to confirm the timely filing of an acceptable translation of the international application into English is DISMISSED without prejudice.

An acceptable translation of the claims contained in the international application as filed was included with the submission filed on May 19, 2006.

At this time the Applicant's are required to pay the \$130 processing fee for filing the translation later than thirty months after the priority date.

Applicant's herein direct that the English translation surcharge of \$130 may be charged to Deposit Account 50-1541. A duplicate copy of this page is also being submitted.

Finally, the Applicant's are directed to avoid additional claims fees based on the 13 claims of record (and the multiple dependencies contained therein) a proper Preliminary Amendment under 37 CFR 1.121 is required.

Applicant's along with this submission have provided a proper Preliminary Amendment, thus making any additional fee requirements

moot.

All filing requirements of this application are now believed to be complete. If you have any questions please do not hesitate to contact the undersigned.

Respectfully submitted,
Attorney for Applicants

By: 

Dara L. Onofrio
Reg. No. 34,889

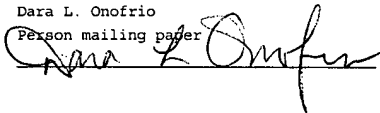
107 Shad Row
Piermont, New York 10968
845.613.0880 tel.
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24 JAN 2007

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DARA L. ONOFRIO
ONOFRIO LAW
107 SHAD ROW
PIERMONT NY 10968

COPY

In re Application of:
BEER, Robert, et al.
U.S. Application No.: 10/561,134
PCT No.: PCT/EP2004/006711
International Filing Date: 22 June 2004
Priority Date: 26 June 2003
Atty Docket No.: ICH 303-US
For: OPTICAL INTENSIFIER
MATERIALS

DECISION

This decision is issued in response to the "Response To Notification Of Missing Requirements" filed 19 May 2006, treated herein as a petition under 37 CFR 1.181 to confirm the timely filing of an English translation of the international application. No petition fee is required.

BACKGROUND

On 22 June 2004, applicants filed international application PCT/EP2004/006711. The international application claimed a priority date of 26 June 2003, and it designated the United States. On 06 January 2005, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 26 December 2005. The published international application included 13 claims.

On 15 December 2005, applicants filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee, a purported translation of the international application into English, and an executed declaration. The English translation of the international application filed on 15 December 2005 included 20 claims.

On 16 March 2006, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements (Form PCT/DO/EO/905) indicating that the translation of the international application filed on 15 December 2005 was defective based on the disparity between the number of claims listed in the translation and the number of claims contained in the international application. The Notification required submission of a proper translation and the processing fee required for filing the translation later than thirty months after the priority date.

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Thus, regardless of whether the modifications incorporated in the translation only involved the moving of language from one claim number to another, the translation is still not an acceptable translation of the claims "as filed," as required by the regulation. Moreover, it is noted that, while the present submission states that the "English Translation submitted with the filing contained 15 claims," the translated claims filed herein on 15 December 2005 actually included 20 claims. Thus, it is possible that additional changes beyond those referred to herein may have been incorporated into the translated claims filed 15 December 2005.

Based on the above, the 20 translated claims filed 15 December 2005 cannot be accepted as a translation of the claims "as filed" in the international application. The required translation was not filed until applicants' 19 May 2006 submission of an English translation of the 13 claims contained in the international application, as filed. Because these materials were not filed until more than thirty months after the priority date, applicants are required to pay the \$130 processing fee for failure to file a proper translation within thirty months of the priority date.

Finally, it is noted that applicants have not submitted a proper preliminary amendment of the claims in compliance with 37 CFR 1.121, and the application file does not include an indication that these claims were amended during the international phase of the application. Accordingly, the claims of record remain the 13 claims set forth in the international application.

CONCLUSION

Applicants' petition under 37 CFR 1.181 to confirm the timely filing of an acceptable translation of the international application into English is **DISMISSED** without prejudice.

An acceptable translation of the claims contained in the international application as filed was included with the present submission filed 19 May 2006.

Based on the above, applicants are required to pay the \$130 processing fee for filing the translation later than thirty months after the priority date, as set forth in the Notification Of Missing Requirements mailed 16 March 2006. The present submission included the authorization to charge Deposit Account No. 50-1541 for this fee; however, when this charge was attempted, the Deposit Account did not include the necessary funds. Accordingly, applicants' response to the Notification Of Missing Requirements mailed 16 March 2006 is defective.

Applicants have **ONE (1) MONTH** from the mail date of this decision to submit payment of this \$130 processing fee. Failure to submit a timely and proper response will result in abandonment of the application.

EXTENSIONS OF TIME UNDER 37 CFR 1.136(a) ARE NOT AVAILABLE.

It is also noted that, if applicants desire to avoid additional claims fees based on the 13 claims of record (and the multiple dependencies contained therein), a proper Preliminary Amendment under 37 CFR 1.121 is required.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

A handwritten signature in dark ink, consisting of a series of loops and a final vertical stroke, representing the name Richard M. Ross.

Richard M. Ross

Attorney Advisor

Office of PCT Legal Administration

Telephone: (571) 272-3296

Facsimile: (571) 273-0459